

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of: Howard G. Page et al.

Confirmation No.: 8911

Application No.: 09/498,515

Group No.: 3622

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Examiner: Yehdega Retta

For: ADVERTISING INSERTION FOR A VIDEO-ON-DEMAND SYSTEM

**Mail Stop: Appeal Brief-Patents**

Commissioner for Patents

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**AMENDMENT UNDER 37 C.F.R. § 41.50(b) IN RESPONSE TO BOARD  
DECISION ON APPEAL EMPLOYING NEW REJECTION**

**Introductory Comments**

In its Decision on Appeal (hereinafter “the Decision”), the Board of Patent Appeals and Interferences (hereinafter “the Board”) affirms the rejection of claims 1, 2, 5-8, 10-13, 16-18, 20-23, and 25-27. (Page 18 of the Decision.) In addition, the Board designates the affirmance as a new rejection within the meaning of 37 C.F.R. § 41.50(b), due to its reliance on prior art not cited by the Examiner. (Id.) In response, please consider the enclosed amendments and consider the following remarks.

## **Amendments to the Claims**

1-27. (Canceled)

28. (New) A method for providing video advertising, the method comprising:

at a video-on-demand system, receiving and processing a request from a target viewer for selected video content;

at the video-on-demand system, selecting video advertising that has a subject matter relation to the selected video content requested by the target viewer;

at the video-on-demand system, determining insertion points in the selected video content for the selected video advertising;

transferring the selected video content, the selected video advertising, and the insertion points from the video-on-demand system to a target viewer device;

at the target viewer device, storing the selected video advertising;

at the target viewer device, transferring the selected video content in a video stream to a display device; and

at the target viewer device, interrupting the transfer of the selected video content in the video stream, inserting the stored selected video advertising into the video stream, and resuming the transfer of the selected video content in the video stream at the insertion points in the selected video content.

29. (New) The method of claim 28, further comprising, at the display device, receiving the video stream from the target viewer device and displaying the video stream to the target viewer.

30. (New) The method of claim 28, further comprising, at the video-on-demand system, selecting the selected video advertising based on a viewer profile for the target viewer.

31. (New) The method of claim 28, further comprising, at the target viewer device, re-displaying the selected video advertising after rewinding the selected video content.

32. (New) The method of claim 28, further comprising, at the target viewer device, disabling fast-forward capability when the selected video advertising is displayed.

33. (New) The method of claim 28, wherein transferring the selected the selected video content occurs over a first transport system, transferring the selected video advertising occurs over a second transport system, and the first transport system uses greater bandwidth for video transfer than the second transport system.

34. (New) The method of claim 33, wherein transferring the insertion points occurs over at least one of the first transport system and the second transport system.

35. (New) A video advertising insertion system, comprising:

- a video-on-demand system configured to receive and process a request from a target viewer for selected video content, select video advertising that has a subject matter relation to the selected video content requested by the target viewer, determine insertion points in the selected video content for the selected video advertising, and transfer the selected video content, the selected video advertising, and the insertion points; and

- a target viewer device configured to receive the selected video content, the selected video advertising, and the insertion points transferred from the video-on-demand system, store the selected video advertising, transfer the selected video content in a video stream to a display device, and interrupt the selected video content in the video stream, insert the stored selected video advertising into the video stream, and resume the transfer of the selected video content in the video stream at the insertion points in the selected video content.

36. (New) The video advertising insertion system of claim 35, further comprising the display device, wherein the display device is configured to receive the video stream from the target viewer device and display the video stream to the target viewer.

37. (New) The video advertising insertion system of claim 35, wherein the video-on-demand system is configured to select the selected video advertising based on a viewer profile for the target viewer.
38. (New) The video advertising insertion system of claim 35, wherein the target viewer device is configured to re-display the selected video advertising after rewinding the selected video content.
39. (New) The video advertising insertion system of claim 35, wherein the target viewer device is configured to disable fast-forward capability when the selected video advertising is displayed.
40. (New) The video advertising insertion system of claim 35, wherein the video-on-demand system is configured to transfer the selected the selected video content to the target viewer device over a first transport system, and transfer the selected video advertising to the target viewer device over a second transport system, wherein the first transport system uses greater bandwidth for video transfer than the second transport system.
41. (New) The video advertising insertion system of claim 40, wherein the video-on-demand system is configured to transfer the insertion points to the target viewer device over at least one of the first transport system and the second transport system.

## **Remarks**

Claims 1, 2, 5-8, 10-13, 16-18, 20-23, and 25-27 stand rejected, as affirmed in the Decision. In response, claims 1-27 are canceled, and new claims 28-41 are added as a substitute therefor. The Appellant respectfully traverses the rejection and requests allowance of claims 28-41.

## **Claim Rejection Under 35 U.S.C. § 103**

Claims 1, 2, 5-8, 10-13, 16-18, 20-23, and 25-27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,718,551 to Swix et al. (hereinafter “Swix”) in view of “NDS: NDS’ XTV™ Time Shifting Technology Empowers the Viewer and the Broadcaster,” M2 Presswire (Sept. 10, 1999) (hereinafter “XTV”), U.S. Patent No. 6,588,015 to Eyer et al. (hereinafter “Eyer”), and Digital Audio-Visual Council, “DAVIC 1.2 Specification Part 4, Delivery System Architecture and Interfaces” (1997) (hereinafter “DAVIC”). (Pages 3, 4, and 18 of the Decision.)

In response, claims 1-27 are canceled, and new claims 28-41 are added as a substitute for the canceled claims. Generally, the new claims more explicitly describe the various operations of the distributed video advertising insertion system explicated in Figs. 2 and 3, as well at page 5, line 16, to page 7, line 20, of the present application. More specifically, independent method claim 28 and independent video advertising insertion system claim 35 both indicate that a video-on-demand system receives and processes a request for a selected video content, selects video advertising that has a subject matter relation to the selected video content, determines insertion points in the selected video content for the selected video advertising, and transfers the selected video content, the selected video advertising, and the insertion points to a target viewer device. The target viewer device receives the selected video content, the selected video advertising, and the insertion points, and stores the selected video advertising. The target viewer device also transfers the selected video content in a video stream to a display device, inserts the selected video advertising stored therein into the video stream, and then resumes the transfer of the selected video content at each of the insertion points in the selected video content.

The Appellant respectfully contends that the combination of Swix, XTV, Eyer, and DAVIC fails to teach or suggest all of the provisions of independent claims 28 and 35. For example, Swix proposes different models for delivering targeted advertisements to users via a set-top box depending on whether an interactive session (column 10, line 20, to column 12, line 59), or broadcast programming (column 12, line 60, to column 13, line 54) is involved.

For interactive sessions, through which a pay-per-view movie may be ordered, Swix discusses two specific ways in which advertising may be delivered: (1) through a viewer's use of an interactive menu screen (column 10, line 34, to column 11, line 57), and (2) via playlist advertisement insertion (column 11, line 57, to column 12, line 59). In the first case, an advertisement is displayed to the user after selection of one or more interactive menu items. (See Fig. 3.) The advertisement may be a bit map or a video advertisement, and may be either downloaded from a head-end at the time of selection or previously stored in the set-top box. However, in this example, the advertising is not displayed during any kind of selected video content, as set forth in claims 28 and 35, but is instead shown only during interaction with the set-top box menu system. Also, the use of insertion points is not discussed therein.

In the case of playlist advertisement insertion for interactive sessions, Swix employs the head-end to build a playlist (see Fig. 4), in which targeted advertisements are placed *before and after* a program, such as a movie. (See also column 11, lines 61-66.) As a result, Swix does not teach or suggest insertion points *in* a selected video content, as set forth in claims 28 and 35, but just provides a list of advertisements in a particular order surrounding a video program ordered by the viewer. Moreover, since insertion points in the selected video content are not involved, Swix also does not teach or suggest the interruption of the selected video content at the insertion points to insert the selected video advertising, as provided for in claims 28 and 35.

For broadcast advertisement insertion, Swix relies on switching between communication channels at the set-top box to deliver the advertising, with the head-end indicating to the set-top box by way of q-tones when the switching occurs (see column 13, lines 10-36). Also, one of the broadcast channels may be a channel broadcasting a continuous stream of advertisements. (Column 13, lines 37-46.) However, in this

embodiment, Swix does not teach or suggest a target viewer device receiving selected content, advertising, and insertion points, storing the advertising, delivering the content in a video stream, and then interrupting the selected content, inserting the stored advertising, and resuming the selected content at the insertion points, as provided in claims 28 and 35. Further, as this particular portion of Swix involves only broadcast programming, and not video content specifically selected by the viewer, the targeted advertising appears to be based only upon a previously-generated customer profile or demographic group of subscribers (see column 13, lines 24-29), and thus not upon the selected video content being transferred, as provided for in claims 28 and 35. Also, since multiple video broadcasting channels are involved, Swix does not indicate or suggest that the head-end ever receives a request for selected video content, as provided for in claims 28 and 35, as such an indication is not needed to select between multiple channels being broadcast simultaneously, as shown in Fig. 5.

Thus, based at least on the foregoing, the Appellant contends that new claims 28 and 35 are allowable in view of the combination of Swix, XTV, Eyer, and DAVIC, and such indication is respectfully requested.

In addition, dependent claims 29-34 depend from independent claim 28, and claims 36-41 depend from independent claim 35, thus incorporating the provisions of each of these independent claims. Therefore, the Appellant asserts that claims 29-34 and 36-41 are also allowable for at least the same reasons as those presented above in support of claims 28 and 35, and such indication is respectfully requested.

Claims 1-27 are canceled herein, thus obviating the rejection as it pertains to these claims.

Therefore, in view of the above discussion, the Appellant respectfully requests withdrawal of the 35 U.S.C. § 103(a) rejection of claims 1, 2, 5-8, 10-13, 16-18, 20-23, and 25-27.

## **Conclusion**

Based on the above remarks, the Appellant submits that claims 28-41 are allowable. Additional reasons in support of patentability exist, but such reasons are omitted in the interests of clarity and brevity. The Appellant thus respectfully requests allowance of claims 28-41.

The Appellant believes no fees are due with respect to this filing. However, should the Office determine fees are necessary, the Office is hereby authorized to charge Deposit Account No. 21-0765 accordingly.

Respectfully submitted,

Date: 01/07/2008

/Kyle J. Way/

### **SIGNATURE OF PRACTITIONER**

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